

**II. Rejection under 35 U.S.C. § 103**

Claims 1-168 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,009,880 (Grollier et al.). *Office Action* at pp. 2-3. Applicants respectfully traverse this rejection.

The Examiner disagrees with Applicants' arguments "because the reference teaches a singly dyeing composition (formulation) comprising the claimed ingredients ... and thus a person of ordinary skill in the art would expect such a composition to have similar properties to those claimed." *Id.*

To establish a *prima facie* case of obviousness, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. M.P.E.P. § 2143.01; 2143.02.

Applicants respectfully disagree that Grollier teaches the claimed composition. Applicants contend that it is not enough to point to isolated passages in a reference to establish a *prima facie* case of obviousness. The art must suggest to one of ordinary skill in the art the desirability of the specifically claimed combination of references. M.P.E.P. § 2143.01.

As argued previously, Grollier discloses a series of long lists of possible ingredients, which can potentially lead to a very large number of potential compositions. But from this large number, Grollier fails to provide specific guidance to Applicants' claimed composition.

For example, among the polymers, Grolier provides seventeen potential classes of polymers:

- (1) quaternary derivatives of cellulose ethers of formula 1 (col. 4-5);
- (2) water soluble polymers of formula 2 or 2' (col. 5-6);
- (3) homopolymers or copolymers derived from acrylic or methacrylic acid according to the formulae at col. 6;
- (4) polymers subdivided into subgenuses (a) - (b) (col. 7-8);
- (5) quaternised polymers of the formulae at col. 8-15;
- (6) copolymers of vinylpyrrolidone of the formula at col. 15;
- (7) polyamino-amides (A) at col. 16;
- (8) crosslinked polyamino-amides as described in col. 16-19;
- (9) water-soluble crosslinked polyamino-amides as described in col. 19-27;
- (10) water-soluble crosslinked polyamino-amide derivatives at col. 27-28;
- (11) polymers obtained by reacting a polyalkylene-polyamine containing two primary amine groups and at least one secondary amine group with certain dicarboxylic acids at col. 29;
- (12) polyalkylene-amines as described in col. 29-30;
- (13) polymers which contain, in the chain, vinylpyridine or vinylpyridinium units, as described in col. 30-31;
- (14) urea-formaldehyde cationic resins (col. 31);
- (15) water-soluble polymers which are condensation products of polyamines and epichlorohydrin (col. 31);
- (16) vinylbenzylammonium homo- or co-polymers; and

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

(17) quaternary polyureylenes (col. 31).

Within the polymer (3) class, *i.e.*, homopolymers or copolymers derived from acrylic or methacrylic acid according to the formulae at col. 6, one of ordinary skill in the art is still faced with many choices: one must choose among homopolymers or copolymers, followed by a choice between one of the three formulae listed in col. 6, and finally between the particular "R" substituents. Thus, Grollier does not suggest, out of the myriad of possible polymer types disclosed in the entire patent, that the claimed polymer is particularly desirable, as required.

Even more specifically, Grollier does not teach the desirability of the combination of the claimed polymer, the at least one fatty alcohol, the at least one alkoxylated fatty alcohol, the at least one fatty amide, and the at least one oxidizing agent. As discussed in the previous Reply, Grollier lists these other ingredients in isolated passages throughout the specification. For example, Grollier describes the use of oxidizing agents in "colouring creams." Col. 52, lines 10-16 and 34-37. Fatty alcohols can be included in "treatment creams or milks to be applied before or after colouring or bleaching." Col. 51, lines 18-25. Fatty amides are listed as a possible non-ionic surface active agent. Col. 48, lines 30-35 and col. 49, lines 5-6. There is no teaching in Grollier, however, that the specifically claimed combination is particularly desirable.

As stressed by the Federal Circuit in *Bausch & Lomb*,

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

*Bausch & Lomb*, 796 F.2d 443, 448 (Fed. Cir. 1986) (quoting *In re Wesslau*, 353 F.2d. 238, 240 (C.C.P.A. 1965)). That, however, is what has happened here. Small isolated passages are selectively chosen to show that Grollier allegedly teaches Applicants' claimed combination, while the remaining vast number of possible formulations taught by Grollier are ignored. One of ordinary skill in the art, when faced with such numerous possibilities, would not draw up a matrix of every potential possible formulation disclosed in Grollier, and then randomly choose Applicants' claimed combination without specific guidance to do so.

Applicants respectfully submit that the current rejection is based on the selective picking and choosing specifically prohibited by the holding of *Bausch & Lomb*. As a result, Applicants respectfully assert that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

### III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

If there is any fee due in connection with the filing of this Preliminary  
Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 22, 2003

By: Maria Bant, Reg. No. 52,516  
for Anthony C. Tridico  
Reg. No. 44,455

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com